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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/843,198

04/26/2001

John R. Hind

RSW9-2001-0016-US1

8824

7590

06/01/2006

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EXAMINER

STEVENS, ROBERT

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,198

Applicant(s)

HIND ET AL.

Examiner

Robert Stevens

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9, 11-31 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7, 9, 11-20 and 33 is/are allowed.
- 6) ☒ Claim(s) 21-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: RCE filed 8/22/2005.
2. This action is **NON-FINAL**.
3. The Office withdraws the previous rejections of claims under 35 U.S.C. §§112-1st and 2nd paragraphs, in view of the amendment filed via the RCE.
4. The Office withdraws the previous rejections of claims under 35 U.S.C. §103(a), in view of the amendment filed via the RCE.
5. The Office asserts new rejections of claims 21-31 under 35 U.S.C. §101, in view of the amendment.
6. Claims 1-7, 9, 11-31 and 33 are pending. Claims 1, 14, 21, 24 and 27 are independent. Claims 8, 10 and 32 have been cancelled.

Allowable Subject Matter

7. **Claims 1-7, 9, 11-20 and 33 are allowable.**

8. **Claims 21-31, however, stand rejected under 35 USC §101.** Claims 21-31 would be allowable if rewritten or amended to overcome the rejections under 35 USC §101, as set forth in this Office Action.

9. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Continued Examination Under 37 CFR 1.114

10. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. **Claims 21-31 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter.

Regarding independent claims 21 and 24: These claims essentially recite converting a document in one format to another format and identifying whether a target system is capable of processing documents in that second format. Although arguably concrete and tangible, the claim does not yield a useful, concrete and tangible result. For instance, there is no conveyance of information that would provide a practical application of the claimed subject matter. The processing/conversion all occurs within the confines of a computer, for example, and the resulting conversion is not used for a practical application.

Additionally, claims 21 and 24 encompass software per se.

Claims 22-23 and 25-26 depend upon claims 21 and 24, respectively, and do not correct the deficiencies of those claims. Claims 22-23 and 25-26 are therefore likewise rejected.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Stevens whose telephone number is (571) 272-4102. The examiner can normally be reached on M-F 6:00 - 2:30.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (571) 272-4136. The current fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Additionally, the main number for Technology Center 2100 is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert Stevens
Art Unit 2176
Date: May 19, 2006

rs


WILLIAM BASHORE
PRIMARY EXAMINER